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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,426	10/17/2000	David S. Cortright	MCS-020-99	3341
27662	7590	06/30/2004	EXAMINER	
LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			THOMPSON, MARC D	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/690,426

Applicant(s)

CORTRIGHT ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/17/2000 and 11/3/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. New issues requiring attention have been recognized which must be properly addressed. The finality of the rejection of the last Office action is hereby withdrawn.
3. The after-final amendment received 4/29/2004, has been entered into record.
4. Claims 6-23 are now pending. Claim 9 is the sole independent claim.

#### ***Priority***

5. No claim for priority has been made in this application.
6. The effective filing date for the subject matter defined in the pending claims in this application is 10/17/2000.

#### ***Drawings***

7. The Examiner contends that the original drawings submitted on 10/17/2000 in combination with the updated submitted drawings on 11/3/2003, are acceptable for examination proceedings.

#### ***Specification***

8. The disclosure is objected to because of the following informalities:

Pages 13, 19, and 20, display Tables 1, 2, and 3, respectively, each of which contain non-printable images. This incorporation of non-printable images within the specification is prohibited according to MPEP §608.01, 37 CFR §1.58, and 37 CFR §1.81. It is suggested that all three tables be removed from the written description as currently presented, and be reintroduced as additional figures on a single sheet as an additional drawing (for example, as

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Figures 9A-9C or Figures 9-11). The content and referencing of the information within the specification and tables should not be altered.

9. Minimally, all remedies to this problem require the removal of the non-printable images from the specification. Examiner suggests the information contained within the tables not be removed from the specification, since these tables are very descriptive and generally helpful in facilitation of understanding of the invention as a whole.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 9 recites the limitation “the at least one email address field” in Lines 10-11 of the claim. There is insufficient antecedent basis for this limitation in the claim. It is suggested “the at least one email address field” remain consistent with the prior naming of the field in prior lines of the claim, namely, “the at least one field in the preview pane or full message window which contains one or more email addresses” to remove any potential ambiguity.

***Reasons for Allowance***

13. The following is an Examiner's statement of reasons for allowance:

The presented claims are allowed over the prior art of record as previously indicated in the advisory action issued on 4/9/2004. The provision for the combination of identification of a

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(valid) electronic message address by identification of an electronic message header containing address(es) through parsing header address field(s), subsequent comparison of the obtained address by determination if the address corresponds to a given entity in a stored set of logical address collections by ensuring that the user computer is communicatively coupled with at least one remote server storing said logical address collections (lists) in order to further ensure that the electronic message address is resident/present within a remotely stored address list and to determine all corresponding electronic mail address associations, and when determined, adjacently marking the electronic message address with an appropriate indicator (icon) based on these determination(s), such that the electronic address may be manipulated as an object (entity) through the use of a graphical user interface. This functionality is supported by the specification, inter alia, at Page 3, Line 12 through Page 4, Line 27, Page 12, Line 28 through Page 15, Line 10, Figure 3, and Figures 4A-4C. Also see, Tables 1, 2, and 3, as originally presented in the specification.

### ***Conclusion***

14. This application is in condition for allowance except for the above formal matters. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 703-308-6750. The examiner can normally be reached on Monday-Friday, 9am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON  
**MARC THOMPSON**  
PRIMARY EXAMINER  
Marc D. Thompson  
Primary Examiner  
Art Unit 2144